REMARKS

This paper is filed in response to the Office Action mailed on October 5, 2005. Currently, Claims 1-34 are pending in the application. Claims 1-34 have been examined and stand rejected. Reconsideration of Claims 1-34 is respectfully requested.

The Objection to the Claims

Claims 1 and 25 have been amended to correct typographical errors. Accordingly, applicant respectfully requests the Examiner withdraw the objection to the claims.

The Objection to the Specification

The specification has been reviewed, and several amendments have been made, including the listing of the issued patent and the correction of reference numerals throughout the specification. The Examiner is thanked for the careful review of the specification.

The Rejection of Claims 1-34 Under Obvious-Type Double Patenting

Claims 1-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,637,038. The Examiner states, "although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the parent patent include the combination of structural features as outlined in Claims 1-34."

Applicant respectfully traverses the rejection.

> In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is—does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an "obviousness-type" nonstatutory double patenting rejection may be appropriate.

See M.P.E.P. § 804.II.B.1, page 800-21, Rev. 3, August 2005. Further, "a double-patenting rejection of the obviousness-type is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

double patenting rejection is not considered prior art." *See* M.P.E.P. § 804.II.B.1, page 800-21, Rev. 3, August 2005.

Claims 1-25 of the application recite, in part, "at least one lower intake aperture in said goggle body, said intake aperture in communication with said eye cavity (and)...at least one channel formed in an upper surface of said ledge, said channel dimensioned to focus air approaching said channel from diverse angle, onto said lower intake aperture...."

Applicant submits that the above recitation is not an obvious variation of any element of any claim in the patent.

As regards Claims 25-34, applicant submits that sub-combinations can be patentably distinct from combinations. A situation such as is can arise if the combination does not require the particulars of the sub-combination for patentability, and the sub-combination has separate utility. *See* M.P.E.P. § 806.05(c)(II), page 800-44, Rev. 3, August 2005. "Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is not **patentably distinct** from the subject matter claimed in a commonly owned patent." *See* M.P.E.P. § 804.II.B.1, page 800-21, Rev. 3, August 2005.

Claim 25 of the application recites, "exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture, whereby air entering said eye cavity is pulled from said eye cavity by said negative air pressure adjacent to said venting aperture." Claim 1 of the patent does not have, at least, the particulars of Claim 25 of the application. Accordingly, applicant submits that Claim 1 of the patent does not rely on the particulars of the sub-combination recited in Claim 25 of the application to be patentable. Therefore, applicant submits Claim 25 is patentably distinct from Claim 1.

Accordingly, the withdrawal of the rejection is respectfully requested.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The Rejection of Claims 25-29 and 31-34 Under 35 U.S.C. § 102(b)

Claims 25-29 and 31-34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tackles et al. (U.S. Patent No. 6,009,564). Applicant respectfully disagrees.

As regards Claim 25, the Examiner indicates that feature 24 in the Tackles patent is the "surface dimensional means" that creates negative air pressure. The Tackles patent describes a double frame construction built from a front frame portion and a rear frame portion, wherein the lens is held captive between the front and rear frame portions. (Col. 5, lines 27-30.) The feature 24 is the front frame portion. Applicant submits that there is no description in the Tackles patent that the front frame portion 24 creates negative air pressure to thereby vent the eye cavity through the side vent aperture.

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because the Tackles patent does not describe, at least, an "exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture," the Tackles patent is not anticipatory.

Further, as regards Claim 29, the Examiner indicates that feature 36 in the Tackles patent corresponds to the upper intake aperture. The Tackles patent describes feature 36 as a membrane through which air is exhausted. (Col. 6, lines 4-7.) Therefore, applicant submits that the feature 36 in the Tackles patent cannot be an intake aperture when used to exhaust air.

For a reference to be anticipatory, the reference must exactly describe the claimed invention. Because the Tackles patent does not describe, at least, "upper intake apertures," the Tackles patent is not anticipatory.

Accordingly, the withdrawal of the rejection is respectfully requested.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

The Rejection of Claim 30 Under 35 U.S.C. § 103(a)

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tackles et al. in view of Tsubooka (U.S. Patent No. 6,601,240). Applicant respectfully disagrees.

For an obviousness rejection, there must be a suggestion or motivation either in the references or in the knowledge generally available to modify a reference or to combine references. There must be a reasonable expectation of success, and all the claim limitations must be taught or suggested in the prior art. Claim 30 is dependent from Claim 26, which is dependent from Claim 25.

The Tackles patent fails to teach or suggest an "exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture." The Tsubooka patent does not teach or suggest an "exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture." For obviousness, the combination of references must teach or suggest every limitation of a claim. Because neither the Tackles patent nor the Tsubooka patent teach or suggest an "exterior surface dimensional means to direct airflow thereover to create negative air pressure immediately adjacent to said venting aperture," Claim 25 is patentable in view of the Tackles patent, alone or combined with Tsubooka. Accordingly, Claim 30 is also patentable.

Claim Amendments

Claims 1, 2, 19, 20, 22, 23-25, 27, and 28 were amended to correct typographical errors, not for a reason related to patentability.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

CONCLUSION

In view of the foregoing remarks, applicant respectfully requests the allowance of Claims 1-34. If there are any further questions or comments, the Examiner may contact the applicant's attorney at the number provided below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS[PLLC]

Laura A. Cruz
Registration No. 46,649
Direct Dial No. 206.695.1725

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

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LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS[PLLC]
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100